

REMARKS

After entry of this amendment, 1-6, 8-21, 24-51, 53-56, 58 and 60-75 will be pending for the Examiner's review and consideration. Claims 1, 8, 10, 31, 51, 55, and 59 have been amended. Claims 7, 52, 57, and 59 have been cancelled without prejudice. No new matter has been added. Reconsideration and allowance of the present application in view of the above amendments and the following remarks is respectfully requested.

This amendment responds to the office action mailed March 10, 2004. In the office action the Examiner:

- objected to the specification, and in particular rejected the title of the application for being non-descriptive;
- objected to claim 10 as being inconsistent with the drawings;
- rejected independent claim 1 under 35 U.S.C. 103(a) as being unpatentable over United States Patent No. 5,545,164 to Howland ("Howland") in view of United States Patent 5,954,722 to Bono or United States Patent No. 5,981,145 to Morrison et al. ("Morrison"); and
- rejected independent claims 21 and 51 under 35 U.S.C. 103(a) as being unpatentable over Howland.

Amendment to the Specification

In response to the Examiner's request, the title of the application will be amended, if necessary, upon the allowance of claims.

Dependent claim 10

Dependent claim 10 was objected to as being inconsistent with the drawings. In response thereto dependent claim 10 has been amended to recite wherein the diameter of the tapered hole decreases from the back side to the front side. It is respectfully submitted that the drawings depict a tapered hole that has a diameter which decreases from the back side to the front side. Thus, it is respectfully submitted that dependent claim 10 has been amended to overcome the informality noted by the Examiner. Withdrawal of this rejection is respectfully requested.

Independent Claim 1

Independent claim 1 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Howland in view of Bono or Morrison. As amended, independent claim 1 recites, *inter alia*, an occipital plate comprising a Y-shaped plate portion having a central portion, at least one leg portion and at least one clamping portion disposed on the front side proximate a free end of the at least one leg portion; wherein the clamping portion comprises a pivot member and a clamp plate, the clamp plate being pivotable about the pivot member and includes an extension sized and configured to engage an arcuate stepped-in portion formed on the leg portion of the plate to limit the amount of pivot between the clamp plate and the plate. There is no disclosure, teaching, or suggestion in Howland, Bono, and/or Morrison, either alone or in combination, of an occipital plate having a pivotable clamp plate, wherein the occipital plate has an arcuate stepped-in portion for mating with an extension protruding from the clamp plate to limit the amount of pivot between the clamp plate and the plate. It is respectfully submitted that independent claim 1 is thus allowable over the cited prior art. Withdrawal of this rejection and allowance of independent claim 1 is respectfully requested.

Moreover, in order to expedite prosecution of the present invention, it is respectfully submitted that the Examiner's contention that it would have been obvious for one skilled in the art to modify Howland to include an arcuate stepped-in portion for mating with an extension protruding from the clamp plate is impermissible hindsight reconstruction. That is, even though the Examiner acknowledges that Howland does not disclose, teach, or suggest an occipital plate having an arcuate stepped-in portion, nor a clamp plate having an extension sized and configured to engage the arcuate stepped-in portion, the Examiner states that "this or any other attachment would be obvious to one with ordinary skill in the art, for properly securing and fastening the system." It is respectfully submitted that this is impermissible hindsight reconstruction.

In order to establish a *prima facie* case of obviousness, the Examiner bears the burden of establishing three basic criteria. First, the Examiner must show that there was some suggestion or motivation, either in the references themselves or in the knowledge generally available to one skilled in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art references must teach or suggest all of the claim limitations. *See* MPEP § 2142; *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991).

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art, and not based on the applicant's disclosure. Therefore, making a legal determination of obviousness does not mean that one can "pick and choose among the individual elements of assorted prior art references to recreate the claimed invention." *Smithkline Diagnostics, Inc. v. Helena Laboratories Corp.*, 858 F.2d 878, 8 USPQ2d 1468 (Fed. Cir. 1988). Rather, the Examiner must show, not that each element existed in the prior art, but that some teaching or suggestion in the references made obvious the invention as a whole. *Carella v. Starlight Archery*, 804 F.2d 135, 231 USPQ 644 (Fed. Cir. 1986); *Northern Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931, 15 USPQ2d 1321 (Fed. Cir. 1990).

It is respectfully submitted that the Examiner has not satisfied the burden of establishing that there was some suggestion or motivation to modify Howland to include an arcuate stepped-in portion and a clamp plate having an extension sized and configured to engage the arcuate stepped-in portion. Rather, Howland discloses an occipital plate having a lower occipital plate 360, an upper occipital plate 400, an occipital plate stud 420, and a nut 352, the lower and upper occipital plates 360, 400 each including an aperture 372, 374 for receiving and mating with the stud 420 so that the lower and upper occipital plate 360, 400 can be fixed with respect to one another upon threaded engagement with the nut 352. It is respectfully submitted that there is absolutely no suggestion or motivation to modify Howland to include an arcuate stepped-in portion for mating with an extension protruding from the clamp plate. Moreover, it is submitted that there was no suggestion or motivation within the knowledge generally available to one skilled in the art at the time of filing this application to modify the pivotable clamping portion of Howland to include an arcuate stepped-in portion for mating with an extension protruding from the clamp plate.

Rather, it is respectfully submitted, that the Applicant through his own effort and expense derived the device as claimed in independent claim 1. It is respectfully submitted that without the benefit of the Applicant's disclosure, it would not be obvious for one of ordinary skill in the art to modify Howland to include an arcuate stepped-in portion for mating with an extension protruding from the clamp plate. One cannot simply use the Applicant's disclosure as a blueprint to pick and choose among the individual elements of assorted prior art references in order to combine the right references in the right way to achieve the Applicant's claimed invention. *Grain Processing Corp. v. American Maize-Products Corp.* 840 F.2d 902 (Fed. Cir. 1988). Thus, it is respectfully submitted that

independent claim 1 is allowable over the cited prior art. Withdrawal of this rejection and allowance of claim 1 is respectfully requested.

Claims 2-6, 8-20, and 24-27 all ultimately depend from independent claim 1, and thus, it is respectfully submitted that these claims are equally allowable. Withdrawal of the respective rejections and allowance of claims 2-6, 8-20, and 24-27 is therefore respectfully requested.

Independent Claim 21

Independent claim 21 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Howland. Independent claim 21 recites an occipital plate comprising, *inter alia*, a pivotable clamp plate with a hole for receiving a post, wherein the plate includes an arcuate stepped-in portion adjacent the post and the clamp plate further includes an extension sized and configured to engage the arcuate stepped-in portion. As stated above in connection with independent claim 1 there is no disclosure, teaching, or suggestion in Howland of an occipital plate having a pivotable clamp plate, wherein the occipital plate has an arcuate stepped-in portion for mating with an extension protruding from the clamp plate. Thus, for the same reasons identified above in regards to the non-obviousness of independent claim 1, it is respectfully submitted that independent claim 21 is allowable over the cited prior art. Withdrawal of this rejection and allowance of claim 21 is respectfully requested.

Claims 28-50 all ultimately depend from independent claim 21, and thus, it is respectfully submitted that these claims are equally allowable. Withdrawal of the respective rejections and allowance of claims 28-50 is therefore respectfully requested.

Independent Claim 51

Independent claim 51 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Howland. As amended independent claim 51 requires, *inter alia*, an occipital plate comprising a front side and a back side, a central portion, and at least one leg portion having and a V-shaped rod-receiving first recess and an arcuate stepped-in portion; at least one pivotable clamping portion disposed on the front side of the at least one leg portion; wherein the at least one leg portion includes a post hole and the at least one clamping portion includes a pivot member and a clamp plate; the pivot member being sized and configured to mate with the clamp plate and the post hole and the clamp plate includes a rod-receiving second recess sized and configured to align with the V-shaped first recess and an extension sized and

configured to engage the arcuate stepped-in portion. As stated above in connection with independent claim 1 there is no disclosure, teaching, or suggestion in Howland of an occipital plate having a pivotable clamp plate, wherein the occipital plate has an arcuate stepped-in portion for mating with an extension protruding from the clamp plate. Moreover, there is no disclosure, teaching, or suggestion in Howland of providing a V-shaped first recess. Thus, it is respectfully submitted that independent claim 51 is allowable over the cited prior art.

Withdrawal of this rejection and allowance of claim 51 is respectfully requested.

Claims 53-56, 58, and 60-75 all ultimately depend from independent claim 51, and thus, it is respectfully submitted that these claims are equally allowable. Withdrawal of the respective rejections and allowance of claims 53-56, 58, and 60-75 is therefore respectfully requested.

In light of the above amendments and remarks, it is respectfully submitted that claims 1-6, 8-21, 24-51, 53-56, 58 and 60-75 are now in condition for allowance, and the Examiner is respectfully requested to reconsider this application with a view towards allowance. The Examiner is invited to call the undersigned attorney at 212-790-6348, if a telephone call could help resolve any remaining issues.

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Respectfully submitted,

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